

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 3-12, 14-23, 25-26, 38-41, and 43-55 are pending in the present application.

In the outstanding Office Action, Claims 1, 3-11, 50, and 51 were rejected under 35 U.S.C. §103(a) as unpatentable over Honma (U.S. Patent No. 6,304,313) in view of Safai et al. (U.S. Patent No. 6,304,313, herein Safai), Nemoto et al. (JP 9-23375, herein Nemoto), and further in view of Naito et al. (U.S. Patent No. 6,980,668, herein Naito); Claims 12, 14-23, 25-33, and 52-55 were rejected under 35 U.S.C. §103(a) as unpatentable over Honma in view of Safai, Fellegara et al. (U.S. Patent Publication No. 2001/0015760), Nemoto, and further in view of Naito; Claims 36 and 38 were objected to for depending from a rejected base claim, but were otherwise indicated as including allowable subject matter; and Claims 34, 35, 39-41 and 43-49 were allowed.

Applicants thank the Examiner for the indication of allowable subject matter and for the allowance of Claims 34, 35, 39-41 and 43-49.

Applicants respectfully traverse the outstanding ground of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness by asserting prior art that, no matter how the prior art references are combined, does not teach every element of independent Claim 1.

To establish a *prima facie* case of obviousness, MPEP §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all

the claim elements. The outstanding Office Action is deficient with respect to the first and third requirements.

Claim 1 recites, *inter alia*, “in the text shooting mode, said storage unit stores shooting condition data in a one-to-one correspondence with the compressed image data, and the image processing unit effects the image processing to the image data based on said shooting condition data.”

The outstanding Office Action states “...Honma in view of Safai et al. in view of Nemoto et al. fails to disclose the storage unit storing shooting condition data in a one-to-one correspondence with the compressed image data, and the image processing unit effects the image processing to the image data based on the shooting condition data.”¹

The outstanding Office Action relies on Naito to disclose the above-noted elements of Claim 1. Applicants respectfully submit that Naito does not cure the deficiencies in Honma, Safai, and Nemoto.

Naito describes a method and apparatus for adding a watermark to an image. The outstanding Office Action cites to Fig. 37 of Naito to support the rejection of Claim 1. However, Fig. 37 is a diagram showing the data structure of the watermark information management table. The watermark information management table stores information for the application of an electronic watermark to an image. When an original image is registered in the system, data corresponding to instructions from the copyright holder are also registered.

As shown in Fig. 37 of Naito, the watermark information table stores information regarding an ID for the image, a purpose of the image, the time to apply the watermark, the type of watermark to be applied, and the information contained in the watermark.

However, Fig. 37 of Naito has nothing to do with storing shooting condition data in a one-to-one correspondence with compressed image data. Moreover, Naito does not even

¹ Office Action, page 4.

disclose a camera. Since there is no camera, shooting condition data is not a concern of the system disclosed in Naito.

When the image registration process is occurring in Naito, the image has already been created. The watermark data, the time when the watermark is applied, the type of watermark, intended purpose, and image ID are not shooting condition data. The information shown in Fig. 37 has nothing to do with how the image data is acquired.

Furthermore, Naito does not disclose or suggest that the image processing unit effects the image processing to the image data based on said shooting condition data. The outstanding Office Action states "...according to the intended purpose of the image (which can be text) the watermark is applied at certain times according to the table."² Assuming, arguendo, that applying a watermark to an image is image processing, there is no disclosure or suggestion that the watermark is applied in accordance with shooting condition data. The intended purposes disclosed in Fig. 37 of Naito are "original image," "for display/edit," and "for edit." These intended purposes are not shooting condition data.

Furthermore, not only do the cited references fail to teach all of the features of independent Claim 1 as discussed above, but a person of ordinary skill in the art would have no motivation to combine such disparate reference as Naito to remedy the deficiencies of Honma, Safai, and Nemoto.

Honma, Safai, and Nemoto relates to digital cameras, while Naito relates to watermarking image data. Clearly, the artisan seeking to practice the invention of Honma, Safai, and Nemoto would have no reason to look to Naito for adding a watermark to an image. Honma, Safai, and Nemoto do not discuss watermarking image data.

Furthermore, the outstanding Office Action does not present a full and reasoned explanation of why the artisan would even consider the disparate Naito reference for

² Office Action, page 5.

combination. The outstanding Office Action justifies the combination of Naito with Homma, Safai, and Nemoto by stating "...in order to apply certain characteristics to an image in accordance with a combination of various protection preferences and the purpose for which the data is to be employed." However, "protection preferences" and "purpose for which the data is to be employed" are not shooting condition data.

Furthermore, see *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and the requirement there for the PTO to "explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious" and the further requirement for a "full and reasoned explanation" at 277 F.3d 1342, 61 USPQ2d 1432-33.

It is only through an improper hindsight reconstruction of the claimed invention that the outstanding Office Action's rejection of Claim 1 can be understood.

The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983)...Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the outstanding rejection.

Thus, in view of the above-noted distinctions, Applicant respectfully submits that Claim 1 (and Claims 3-6 and 50 dependent thereon) patentably distinguish over Honma, Safai, Nemoto, and Naito, taken alone or in proper combination. Applicant respectfully submits that Claims 7, 12, 18, 23, and 29 are similar to amended Claim 1. Thus, Applicant respectfully submits that amended Claims 7, 12, 18, 23, and 29 (and Claims 8-11, 13-17, 19-22, 24-28, and 51-55 dependent thereon) patentably distinguish over Honma, Safai, Nemoto, and Naito, taken alone or in proper combination, for at least the reasons stated for Claim 1.

Moreover, Applicants respectfully traverse the use of Official Notice in the rejections of Claims 50-55. The Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). As set forth in MPEP §2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion.

In addition, Applicants respectfully traverse those grounds for rejection relying of Official Notice. Applicants do not consider the features for which Official Notice were taken to be "of such notorious character that official notice can be taken." Therefore Applicants traverse this assertion. "The examiner should cite a reference in support of his or her position."³

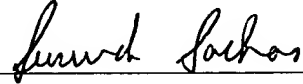
³MPEP 2144.03, page 2100-129, left column, second full paragraph of MPEP 2144.03.

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Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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